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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,499	04/14/2000	G. Victor Guyan	7752.0016-00	9245
28164	7590	05/17/2005	EXAMINER	
ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/550,499	Applicant(s) GUYAN ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the Request for Continued Examination, filed on 1/21/2005.
2. Applicant's request for suspension of action, made under 37 CFR 1.103(c) for a period of 3 months, requested on 1/21/2005, has been granted. The action contained herein was made after the suspension period ended on 4/21/2005.
3. Applicant has amended claims 1, 8, 9 and 13.
4. Claims 1-21 are pending in the case, claims 1, 9 and 13 are independent claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."
6. Claims 1, 8, 9 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such

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a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. **Regarding claims 1 and 13**, the amendment filed 1/21/2005 adds the following limitations: *"wherein the at least one suffix is preselected from one or more types of insurance coverage applicable to the claim"* (first limitations of the claims). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
8. **Regarding claim 8**, the amendment filed 1/21/2005 adds the following limitations: *"field indicates an entity involved with"* (last line of the claim). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
9. **Regarding claim 9**, the amendment filed 1/21/2005 adds the following limitations: *"selected criteria in"* (second limitation of the claim). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

11. Claims 1-21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan et al., US Patent 5,253,362 (filed 1/29/1990, patented 10/12/1993) in view of Borghesi et al., US Patent 5,950,169 (filed 11/9/1995, patented 9/7/1999). "*Nolan et al.*" is hereafter referred to as "*Nolan*". "*Borghesi et al.*" is hereafter referred to as "*Borghesi*".

12. **Regarding independent claim 1**, Nolan discloses prefilling a first set of fields with information identifying a file note. Nolan recites: "*In FIG. 4, a nursing annotation window 480 is illustrated. Window 480 provides a parameter title 481, date 482, time 483*" (column 5, lines 20-22). Nolan discloses the note information comprising a type of note where the type is preselected from a list of types. Nolan recites: "*Additionally, when an annotation is to be entered, such as in FIG. 6, a window 498 may be displayed. Window 498 provides a list of predefined, commonly used annotations*" (column 5, lines 51-54). Nolan discloses a selection of fields from a user and the ability to add data to a text area. Nolan recites: "*Next, in*

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decision step 203, if a standard option is selected from the standard annotation options, process 200 continues on to step 204. In step 204, the standard option selected is entered into the annotation field of the cell. If a standard option is not selected, step 203, or following step 204, the process allows entry of text into the annotation field, step 205" (column 6, lines 40-47).

Nolan discloses generating a note. Nolan recites: *"If the "SHOW DETAIL" selection was made from window 470 of FIG. 3, following the entry of the nursing annotation, a window 486 would be displayed, FIG. 5. Show detail window 486 provides a parameter 487, date 488, time 489, systolic pressure 490, diastolic pressure 491, average pressure 492, date entered 493, time entered 494, entry by 495, and the nurse annotation 496" (column 5, lines 28-34).*

Nolan discloses an annotation system with the prefilling of data by the system from a preselected list of types, a user selecting additional fields for data entry, a user adding data to the predefined text area and the generation of an annotation containing the prefilled data, predefined text fields and the user text. Nolan fails to disclose the use of the annotation system with a suffix indicating a type of insurance coverage for insurance claims. Borghesi discloses an insurance claim processing system. Borghesi recites: *"The present invention provides for a comprehensive method and system for processing insurance claims for use by insurance companies" (column 2 lines 33-35).* Borghesi discloses the use of a suffix indicating the type of insurance

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coverage. Borghesi recites: "*The policy information frame includes type of coverage*" column 9, lines 39-40).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to modify the annotations system described by Nolan to manage insurance claims because "*there is a need for a comprehensive system and method of managing an insurance claim work flow wherein all the tasks of processing a claim may be performed and evaluated*" (Borghesi, column2, lines 20-23).

13. **In regard to dependent claim 2**, Nolan recites: "*This annotation will then be saved in the data base along with the other data for cell 465*" (column 5, lines 26-27).
14. **In regard to dependent claim 3**, Nolan recites: "*Window 498 provides a list of predefined, commonly used annotations*" (column 5, lines 53-54) and "*the process allows entry of text into the annotation field, step 205*" (column 6, lines 46-47).
15. **In regard to dependent claim 4**, Nolan recites: "*Window 480 provides a parameter title 481, date 482, time 483, and a place for the nursing annotation 484*" (column 5, lines 21-22).
16. **In regard to dependent claim 5**, the claim contains substantially the same subject matter as claims 1 and 2 combined, and remains rejected using the same rationale.

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17. **In regard to dependent claim 6**, Nolan recites: "*assigning a first notational designator to said first annotation text*" (column 8, lines 16-17).
18. **In regard to dependent claim 7**, Nolan discloses a category field "*Blood Pressure*" and subcategory fields "*Systolic*" and "*Diastolic*" in Figure 5.
19. **In regard to dependent claim 8**, Nolan discloses a suffix field "Vitals" and a series of related fields ("*Heart Rate*", "*Blood Pressure*", "*Temp.*", and "*Respiration Rate*") that each represent a part of the suffix field in Figure 5.
20. **In regard to independent claim 9**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.
21. **In regard to dependent claim 10**, the claim contains substantially the same subject matter as claims 7 and 8 combined, and remains rejected using the same rationale.
22. **In regard to dependent claim 11**, the claim contains substantially the same subject matter as claim 8, and remains rejected using the same rationale.
23. **In regard to dependent claim 12**, the claim contains substantially the same subject matter as claim 4, and is rejected using the same rationale.

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24. **In regard to independent claim 13**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.
25. **In regard to dependent claim 14**, the claim contains substantially the same subject matter as claim 2, and remains rejected using the same rationale.
26. **In regard to dependent claim 15**, the claim contains substantially the same subject matter as claim 3, and remains rejected using the same rationale.
27. **In regard to dependent claim 16**, the claim contains substantially the same subject matter as claim 4, and remains rejected using the same rationale.
28. **In regard to dependent claim 17**, the claim contains substantially the same subject matter as claim 5, and remains rejected using the same rationale.
29. **In regard to dependent claim 18**, the claim contains substantially the same subject matter as claim 6, and remains rejected using the same rationale.

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30. **In regard to dependent claim 19**, the claim contains substantially the same subject matter as claim 7, and remains rejected using the same rationale.
31. **In regard to dependent claim 20**, the claim contains substantially the same subject matter as claim 8, and remains rejected using the same rationale.
32. **In regard to dependent claim 21**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.

Response to Arguments

33. Applicant's arguments filed 1/21/2005 have been fully considered but they are not persuasive.
34. **Regarding claims 1 and 13**, the applicant states: "*Applicant's respectfully submit that the cited references do not disclose or suggest a file note having such preselected suffix*" (page 6, third paragraph of the amendment filed 1/21/2005). The applicant is directed to the rejections of claims 1 and 13 as restated above.
35. **Also, regarding 1 and 13**, the applicant states: "*In Nolan ... the fanned out forms include fixed fields common to all patients. The fields are not limited to preselected information applicable to a particular patient's condition*" (page 6, fourth paragraph of the amendment filed 1/21/2005). The applicant is directed to the rejections of claims 1 and 13 as restated above. Also, in response to applicant's argument, see Nolan's Figure 4, where patient specific information is shown in relation to the generated note.
36. **Regarding claim 9**, the applicant states: "*the cited references do not disclose or suggest such selected criteria depicted in a criteria section*" (page 7, second paragraph of the amendment filed 1/21/2005). The applicant is directed to the rejection of claim 9 as restated above. Also, in response to applicant's argument, see Nolan's Figure 6, where criteria selection is disclosed at reference sign 498.

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37. **Regarding claim 10**, the applicant states: "*claim 10 includes limitations not included in either claim 7 or 8, and therefore not considered in the office action*" (page 8, first paragraph of the amendment filed 1/21/2005). The applicant is directed to the rejection of claim 10 as restated above. The examiner considers the claim 8 to be substantially the same as the following part of claim 10: *'the criteria section contains a selected suffix and a selected participant, wherein the suffix and the participant are selected by a user in the claim folder screen'* and claim 7 to be substantially the same as the following part of claim 10: *"the criteria section further contains a category and subcategory field containing categories and subcategories selectable by the handler"*.

38. **Also, regarding claim 10**, the applicant states: "*Nolan does not disclose "a claim folder screen" where "information is selected by a user"* (page 8, second paragraph of the amendment filed 1/21/2005). The applicant is directed to the rejection of claim 10 as restated above. In further support of the rejection, consider that while Nolan discloses an annotation system, Borghesi teaches the use of insurance claim information. Borghesi clearly discloses in figure 6 a claim folder screen.

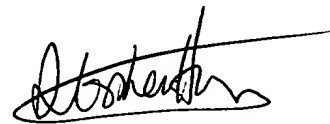
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Conclusion

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Vaughn
May 4, 2005

STEPHEN HONG
SUPERVISORY PATENT EXAMINER